

B⁶ cont
q ranges from 1 to 5, and

further wherein the at least one wax in the fatty phase is capable of conferring a penetration force on the emulsion of greater than or equal to 50 grams.

REMARKS

I. Status Of The Claims

Claims 75-80, 82-94, and 96-108 are now pending in this application. Claims 47-74, 81 and 95 have been cancelled. Claims 75 and 104 have been amended to include the limitations of canceled claims 81 and 95. Claims 82 and 96 have been amended to correct dependency on cancelled claims. New claims 107 and 108 have been added. Support for the new claims can be found, *e.g.*, in the specification and claims, *e.g.*, at page 3, lines 11-14, page 12, lines 18-23, and in Example 1.

Accordingly, no new matter is added by these amendments and no estoppels are intended thereby.

II. Rejections Under 35 USC § 112

Claims 47-106 stand rejected under 35 U.S.C. § 112, second paragraph as allegedly being indefinite for the reasons set forth on pp. 2-3 of the present Office Action. Applicants respectfully traverse this rejection for the following reasons, noting that claims 47-74 are now cancelled.

First, the Examiner states that the phrase "conferring a penetration force on the emulsion" in claims 47, 75 and 104 renders the claims indefinite, alleging that it "is unclear what Applicant intends by this phrase." Office Action, page 2.

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Applicants disagree and refer the Examiner to p. 11 of the specification, wherein at lines 5-8, the specification describes a wax or a mixture of waxes “capable of conferring, on the solid emulsion... a penetration force of greater than or equal to 50 grams.” At lines 9-18, the protocol for measuring this penetration force is described in detail. In particular, the penetration force is measured by preparing the emulsion, casting it in a dish, and maintaining it at 20°C for 24 hours. The penetration force, expressed in grams, is measured on the solid emulsion with a Stevens texture-analyzing device with a TA24 measurement rotor, with a diameter of 4 mm, at a penetration rate of 0.5 mm/s and at a preselected penetration depth of 2 mm. One of ordinary skill in the art would readily be able to carry out this protocol in light of the specification and obtain such penetration force measurements. Thus, in other words, the presence of the wax(es) makes the claimed emulsion solid such that it takes at least 50 g of force to penetrate it 2 mm at the rate of 0.5 m/sec. Claims must be read in light of the specification, and here, as shown above, the specification provides a clear explanation of “conferring a penetration force on the emulsion. Accordingly, this reason for rejection should be withdrawn.

Second, the Examiner states that the term “minimum transfer” in claim 63 is a relative term, which renders the claim indefinite. Applicants disagree. Although claim 63 has been cancelled, this term is present in claim 91, and although the Examiner did not reject this claim, Applicants address the rejection below. The use of relative terminology in a claim does not automatically render that claim indefinite, as the standard for indefiniteness (correctly stated by the Examiner) is whether those of ordinary skill in the art would be reasonably apprised of the scope of the invention. MPEP § 2173.05(b). In claim 63 or 91, read in light of the specification at, *e.g.*, page 2, lines 3-11; page 3, lines 13-14; page 12, lines 18-23; and example 1, the additional ingredient chosen from pigments, pearlescent agents, or fillers is selected such that

minimum or no transfer *of the claimed solid water-in-oil emulsion* occurs. Further, there is no reason why any limits need to be put on the term "minimum transfer." As described in the specification, the claimed solid emulsion can be used in a transfer-free cosmetic composition, *i.e.*, a composition that exhibits little or no transfer. This transfer is disadvantageous, as it may leave marks on clothing or parts of the skin where the cosmetic was not applied, and also requires frequent re-application of the cosmetic composition. *See, e.g.*, specification at page 2. The transfer phenomenon is known in the art and thus the term "minimum transfer" does not need to be quantified for one of ordinary skill in the art to be reasonably apprised of the scope of the claims.

Nevertheless, to make this even more clear, and to advance prosecution, Applicants have amended claim 91 to recite that the additional ingredient is selected so as not to affect any transfer-resistant properties of the emulsion..

For at least the above-stated reasons, it is believed that the pending claims satisfy 35 U.S.C. §112, second paragraph and all rejections should be withdrawn.

III. Rejection Under 35 USC § 102

Claims 47-56, 62-67, 69-84, 90-95 and 97-106 stand rejected under 35 USC § 102(b) as being anticipated by Mellul et al. (EP 595 683 A1, as translated by U.S. Patent No. 5,851,539)¹ for the reasons set forth on pp. 3-5 of the Office Action. Applicants respectfully traverse this rejection for the following reasons.

¹ The Examiner actually refers to EP 374 332 A1 throughout the Office Action, but because (1) the column and line numbers in each instance cited are those of U.S. Patent No. 5,851,539 to Mellul et al. and (2) EP 374 332 A1 is in English, Applicants have assumed that the Examiner intended to apply EP 595 683 A1, which corresponds to U.S. Patent No. 5,851,539.

35 U.S.C. §102 requires that each and every element of a claim be met for a reference to be properly anticipatory. MPEP § 2131. Here, this requirement has not been met.

Independent claim 75 is directed to a solid cosmetic water-in-oil emulsion comprising an aqueous phase emulsified in a fatty phase comprising at least one oil and at least one wax capable of conferring a penetration force on the emulsion of greater than or equal to 50 grams. Claim 75 has been amended to incorporate the limitations of claims 81 and 95, thus reciting “at least one oil in the fatty phase comprises a silicone oil” and “at least one wax is chosen from polyethylene wax, hydrogenated jojoba oil, and ozokerite.” Independent claim 104 relates to a process for making up the skin and/or the scalp, comprising applying a solid emulsion comprising an aqueous phase emulsified in a fatty phase comprising at least one oil and at least one wax capable of conferring a penetration force on the emulsion of greater than or equal to 50 grams. Claim 104 has been amended to include the limitations of claims 81 and 95.

As is clear from the independent claims, the fatty phase of the claimed water-in-oil emulsion must contain a specific wax or waxes that are able to confer the claimed penetration force on the solid water-in-oil emulsion of the invention. For example, the combination of 5.6% hydrogenated jojoba oil, 2.9% polyethylene wax and 7% polytetrafluoroethylene wax confers a penetration force of greater than 50 grams (see Example 1) whereas 4% paraffin wax does not provide this property (see Example 2).

Mellul et al. is drawn to water-in-oil emulsions containing an aqueous phase in a fluorohydrocarbon-containing continuous phase. Although Mellul mentions various types of waxes in a long list of optional additive hydrocarbons (col. 6-7), Mellul fails to disclose the combination of at least one oil comprising a silicone oil, and at least one wax chosen from polyethylene wax, hydrogenated jojoba oil, and ozokerite, where the wax presents the claimed

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penetration forces. Mellul is entirely silent regarding waxes that are capable of conferring a penetration force on the emulsion of greater than or equal to 50 grams. There is no recognition of the significance of using specific wax(es) that have this particular property. This property, however, is a requirement of the present claims. Thus, because each and every element of the present claims is not met by Mellul, it cannot and does not anticipate them.

For at least these reasons, amended independent claims 75 and 104, and the corresponding dependent claims, are not anticipated by Mellul et al. Accordingly, Applicants respectfully request withdrawal of this rejection.

IV. Rejections under 35 USC § 103

A. Mellul et al. and Nicoll et al.

Claims 47-58, 62-67, 69-86, 90-95 and 97-106 stand rejected under 35 USC § 103(a) as being unpatentable over Mellul et al. in view of Nicoll et al. (U.S. Patent No. 5,196,187) for the reasons set forth on pp. 5-6 of the Office Action. Applicants respectfully traverse this rejection for the following reasons.

To establish a *prima facie* case of obviousness, *inter alia*, a combination of prior art references must teach or suggest all the claim elements. *See* M.P.E.P. § 2143. Mellul or Nicoll, alone or in combination, fail to teach or suggest the use of at least one wax capable of conferring a penetration force on the emulsion of greater than or equal to 50 grams. As discussed above, Mellul neither teaches nor suggests the combination of at least one oil comprising a silicone oil, and at least one wax chosen from polyethylene wax, hydrogenated jojoba oil, and ozokerite, where the wax presents the claimed penetration forces, and further does not recognize the benefit of including such waxes in a solid emulsion. Nicoll does not remedy the deficiencies of Mellul,

however, because Nicoll, drawn to water-in-silicone oil emulsions containing certain specific ingredients, fails to teach or suggest waxes that can confer the presently claimed penetration force. Because Mellul or Nicoll do not suggest the desirability of including in their emulsions at least one wax capable of conferring a penetration force on the emulsion of greater than or equal to 50 grams, let alone the specific waxes now required by the amended independent claims, the requirement that all claim elements be met by the combination of references has not been met.

Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness. Accordingly, Applicants respectfully request withdrawal of this rejection.

B. Mellul et al. and Nojima

Claims 47-56, 62-84 and 90-106 stand rejected under 35 USC § 103(a) as being unpatentable over Mellul et al. in view of Nojima (U.S. Patent No. 5,650,139) for the reasons set forth on pp. 6-7 of the Office Action. Applicants respectfully traverse this rejection for the following reasons.

M.P.E.P. § 2143 requires, *inter alia*, that, to establish a *prima facie* case of obviousness, an Examiner must point to some suggestion or motivation, either in the reference itself or in the knowledge generally available to one of ordinary skill in the art, to combine reference teachings. Here, the Examiner has failed to meet this requirement. Mellul is directed to water-in-oil emulsions and provides numerous examples where water is the predominant component of the composition. Nojima relates to oil-based cosmetic compositions and provides numerous examples of compositions free of added water. Those of ordinary skill in the art would readily understand that the water-in-oil emulsions of Mellul are distinctly different from the oil-based compositions of Nojima, and would not have been led to combine the teachings of these two

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references without a suggestion or motivation in the art to do so. No such suggestion or motivation exists, or at least none has been shown by the Examiner. Thus, the Examiner has failed to provide a *prima facie* case of obviousness.

Additionally, Mellul or Nojima, alone or in combination, fail to teach or suggest the use of at least one wax capable of conferring a penetration force on the emulsion of greater than or equal to 50 grams. As discussed previously, Mellul neither teaches nor suggests the combination of at least one oil comprising a silicone oil, and at least one wax chosen from polyethylene wax, hydrogenated jojoba oil, and ozokerite, where the wax presents the claimed penetration forces. Nojima does not remedy the shortcomings of Mellul as a primary reference. Specifically, Nojima does not even teach or suggest emulsions, much less a solid water-in-oil emulsion comprising an aqueous phase and a fatty phase containing such wax(es). Thus the required motivation to combine reference teachings is not present in the cited references. Only impermissible hindsight could give the suggestion to combine teachings to obtain the presently claimed invention..

Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness and Applicant respectfully requests withdrawal of this rejection.

C. Mellul et al. and Nara et al.

Claims 47-56, 59-67, 69-84, 87-95 and 97-106 stand rejected under 35 USC § 103(a) as being unpatentable over Mellul et al. in view of Nara et al. (U.S. Patent No. 4,536,405) for the reasons set forth on pp. 7-8 of the Office Action . Applicants respectfully traverse this rejection for the following reasons.

The combination of Mellul and Nara is improper. Mellul is directed to compositions comprising an aqueous phase emulsified with a silicone surfactant in a continuous phase of a fluorohydrocarbon. Nara, in contrast, teaches makeup compositions comprising ethyl hydroxyethyl cellulose and an aromatic hydrocarbon resin having a softening point of at least about 120°C. Those of ordinary skill in the art would readily understand that the water-in-oil emulsions of Mellul are distinctly different from the ethyl hydroxyethyl cellulose compositions of Nara, and thus would not be drawn to combine the teachings of these references without a suggestion or motivation in the art to do so. As no such suggestion or motivation exists, the Examiner has not established a *prima facie* case of obviousness..

Additionally, Mellul or Nara, alone or in combination, fail to teach or suggest the use of at least one wax capable of conferring a penetration force on the emulsion of greater than or equal to 50 grams. As discussed previously, Mellul neither teaches nor suggests the combination of at least one oil comprising a silicone oil, and at least one wax chosen from polyethylene wax, hydrogenated jojoba oil, and ozokerite, where the wax presents the claimed penetration forces. Nara does not remedy the shortcomings of Mellul as a primary reference. Specifically, Nara does not teach either the presently claimed alkyl dimethicone copolyol or the desirability of using at least one wax capable of conferring a penetration force on the emulsion of greater than or equal to 50 grams. The requisite suggestion or motivation for the combination of the references exists only in hindsight. As a result, the Examiner has failed to establish a *prima facie* case of obviousness.

Accordingly, Applicant respectfully requests withdrawal of this rejection.

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V. Conclusion

In view of the foregoing, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this amendment and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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GARRETT & DUNNER, L.L.P.

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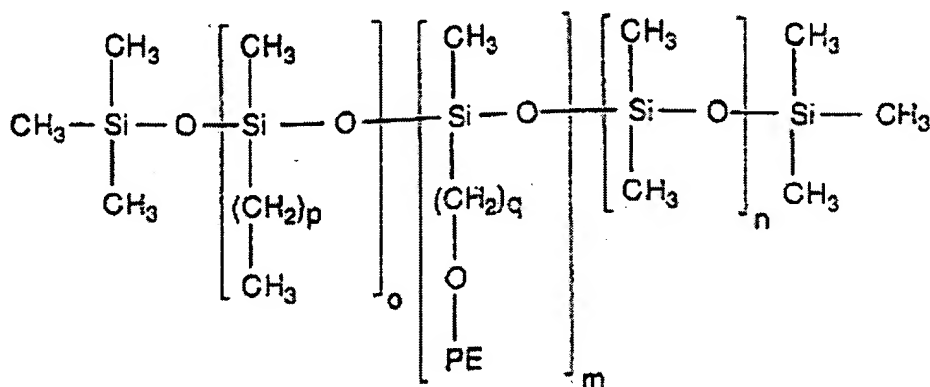
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APPENDIX : MARKED UP CLAIMS

Version with markings shown in compliance with 37 C.F.R. § 1.121:

75. (Amended) A solid cosmetic water-in-oil emulsion comprising an aqueous phase emulsified in a fatty phase comprising at least one oil and at least one wax, wherein the aqueous phase is emulsified using an alkyl dimethicone copolyol corresponding to the following formula:



in which:

PE is $(-\text{C}_2\text{H}_4\text{O})_x(-\text{C}_3\text{H}_6\text{O})_y-\text{H}$,

x ranges from 0 to 50,

y ranges from 0 to 30, with the proviso that x and y are not simultaneously 0,

o ranges from 1 to 100,

m ranges from 1 to 40,

n ranges from 1 to 200,

p ranges from 1 to 17, and

q ranges from 1 to 5, and

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further wherein the at least one wax in the fatty phase is capable of conferring a penetration force on the emulsion of greater than or equal to 50 grams;

further wherein the at least one oil in the fatty phase comprises a silicone oil, and the at least one wax is chosen from polyethylene wax, hydrogenated jojoba oil, and ozokerite.

82. (Amended) The emulsion according to claim [81] **75**, wherein the silicone oil is chosen from volatile cyclic silicones having from 3 to 8 silicon atoms, volatile linear silicones having from 2 to 9 silicon atoms, dimethylsiloxane/methylalkylsiloxane cyclocopolymers, polyalkylsiloxanes with trimethylsilyl end groups, and phenylated silicone oils.

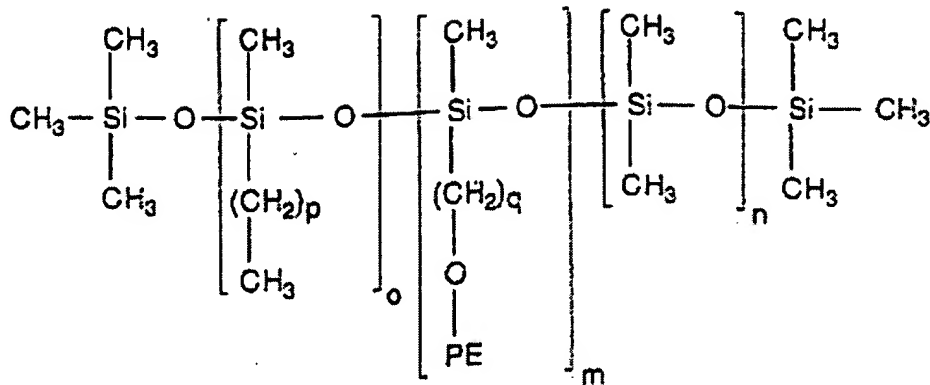
91. (Amended) The emulsion according to claim 75, wherein the fatty phase further comprises at least one additional ingredient chosen from pigments, pearlescent agents, and fillers, and further wherein the at least one additional ingredient is selected [for minimum transfer] **so as not to affect any transfer-resistant properties of said emulsion.**

96. (Amended) The emulsion according to claim [95] **75**, wherein the at least one wax is a mixture of polyethylene wax and of hydrogenated jojoba oil.

104. (Amended) A process for making up the skin and/or scalp, comprising applying to the skin and/or the scalp, a solid **cosmetic water-in-oil** emulsion comprising an aqueous phase emulsified in a fatty phase comprising at least one oil and at least one wax, wherein the aqueous phase is emulsified using an alkyl dimethicone copolyol corresponding to the following formula:

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in which:

PE is $(-\text{C}_2\text{H}_4\text{O})(-\text{CH}_6\text{O})_y-\text{H}$,

x ranges from 0 to 50,

y ranges from 0 to 30, with the proviso that x and y are not simultaneously 0,

o ranges from 1 to 100,

m ranges from 1 to 40,

n ranges from 1 to 200,

p ranges from 1 to 17, and

q ranges from 1 to 5, and

further wherein the at least one wax in the fatty phase is capable of conferring a penetration force on the emulsion of greater than or equal to 50 grams;

further wherein the at least one oil in the fatty phase comprises a silicone oil, and the at least one wax is chosen from polyethylene wax, hydrogenated jojoba oil, and ozokerite.

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